

## **REMARKS**

### **I. Introductory Remarks**

This is a full and timely response to the outstanding final office action mailed March 9, 2010. Claims 1-5 and 7-26 are now pending in this application. Claims 1, 13, and 25 are independent. Claims 1, 2, 13, 18, and 25 have been amended, new claim 26 has been added, and claim 6 has been canceled by this Amendment.

No new matter is involved with any Claim amendment or new claim, as support may be found throughout the originally-filed disclosure.

### **II. Examiner Interview**

This Amendment is being submitted to provide points of discussion during the Examiner Interview scheduled for 3pm on August 10, 2010.

### **III. Written Description Rejection of Claims 1-25 under 35 U.S.C. § 112, ¶1**

Withdrawal of the rejection of claims 1-25 under 35 U.S.C. §112, first paragraph, as allegedly lacking written description support, is requested. Claim 6 has been canceled, thus rendering its rejection moot.

Without conceding the propriety of the rejection, in an effort to expedite prosecution of the application, independent claims 1, 13, and 25 have been amended in a manner that is believed to overcome the stated basis for rejection. Consideration and allowance of claims 1-5 and 7-25 are respectfully requested.

### **IV. Indefiniteness Rejection of Claims 1-25 under 35 U.S.C. § 112, ¶2**

Withdrawal of the rejection of claims 1-25 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite, is requested. Claim 6 has been canceled, thus rendering its rejection moot.

Although the previously presented claims are believed to be clear and definite to a person of ordinary skill in the art, in an effort to expedite prosecution of the application, independent claims 1, 13, and 25 have been amended in a manner that is believed to overcome the stated bases for rejection. Consideration and allowance of claims 1-5 and 7-25 are respectfully requested.

**V. Unpatentability Rejection of Claims 1-3, 5-15, and 17-24 under 35 U.S.C. § 103(a) over Lawrence in View of Barbara**

Withdrawal of the rejection of claims 1-3, 5-15, and 17-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Lawrence (US Pub. No. 2003/0233319) in view of Barbara, et al. (US Pub. No. 2003/0105710) is requested. Claim 6 has been canceled, thus rendering its rejection moot. The Examiner has failed to make a *prima facie* case of unpatentability, particularly with respect to the claims as amended.

**A. Discussion of the Rejection**

**1. Lawrence**

According to its Abstract, Lawrence is purportedly directed to methods and systems for managing risk related to transfer of funds. The method can be implemented in a computer system and indicating in the computer system that a person is a transaction participant according to the person's status as at least one of: a transaction originator; a transaction intermediary, a transaction recipient or a transaction beneficiary. Data can be gathered into the computer system generally related to one or more risk variables. Data can also be received relating details of a financial transaction. The received data can be structured to generally relate to one or more risk variables according to risk criteria. One or more reports can be generated which relate to risk due diligence wherein the report includes an indication that the transaction participant is associated with elevated risk and at least some of the structured data.

Lawrence further asserts that it relates to a method and system for facilitating the identification, investigation, assessment and management of legal, regulatory, financial and reputational risks ("Risks"). In particular, Lawrence allegedly relates to a computerized system and method for banks, non-bank financial institutions and any other entity involved in financial transactions to access information compiled on a worldwide basis and relate such information to a risk variable, such as a political or geographic area involved in a wire transfer, wherein the information is conducive to quantifying and managing financial, legal, regulatory and reputational risk associated with the transaction.

Lawrence attempts to respond to various obligations of Financial Institutions that can include those imposed by the Department of the Treasury and the federal banking regulators

which adopted suspicious activity report ("SAR") regulations. SAR regulations can require that a Financial Institution file a SAR whenever the institution detects a known or suspected violation of federal law, or a suspicious transaction related to a money laundering activity or a violation of the Bank Secrecy Act (BSA). Such regulations can impose a variety of reporting obligations on a Financial Institution. Perhaps most broadly relevant to the purported invention of Lawrence, the reporting obligations require an institution to report transactions aggregating to \$5,000 that involve potential money laundering or violations if the Financial Institution, knows, suspects, or has reason to suspect that the transaction involves funds from illegal activities, is designed to disguise such funds, has no business or legitimate purpose, or is simply not the sort of transaction in which the particular customer would normally be expected to engage, and the institution knows of no reasonable explanation for the transaction after examining the available facts.

Thus, Federal regulators require that Financial Institutions are subject to significant obligations to "know" their customer and to engage in adequate monitoring of transactions. However, bank personnel generally do not have a mechanism available to provide real time assistance to assess a risk factor or otherwise qualitatively manage risk. In the event of a problem, it is often difficult to quantify to regulatory bodies, shareholders, newspapers and other interested parties, diligence exercised by the Financial Institution to properly identify and respond to risk factors. Absent a means to quantify good business practices and diligent efforts to contain risk, a Financial Institution may appear to be negligent in some respect.

Lawrence purportedly responds to the above risks by a method and system that allegedly draws upon information gathered globally and which is utilized to assist with risk management and due diligence related to wire transfers. To alleviate problems inherent in the prior art, Lawrence introduces systems and methods to facilitate ascertaining and managing Risks associated with a wire transfer of money. Whatever valid purpose the purported invention of Lawrence serves in mitigating "suspicious activity", Lawrence does not address "guaranteed funding" of a financial transfer of funds, as specifically claimed by Applicant.

Lawrence discloses at paragraph [0023] that a depository institution that maintains a reserve or clearing account with a Federal Reserve Bank *may use* FEDWIRE® to send payments to, or receive payments from, other account holders directly. Lawrence goes on in that paragraph to indicate that other transfers can include SWIFT, FUNDS, CHIPS, National Automated

Clearinghouse Association (NACHES) formatted transfers, or other electronic or wire transfer platform. ***Lawrence clearly is not directed to, and even more clearly does not provide a teaching or suggestion of coupling FEDWIRE transfers with these other types of transfers to provide guaranteed funding of funds transfers from the U.S. to non-U.S. entities.***

The Examiner admits that Lawrence is deficient with respect to providing a teaching or suggestion of providing guaranteed, self-funding of the transaction to the Receiver Financial Institution, and asserts that Barbara makes up for this admitted deficiency. Applicants traverse this characterization, particularly with respect to independent claims 1 and 13, as amended.

## **2. Barbara**

According to its Abstract, Barbara is purportedly directed to a method and system for on-line payments that makes use of computer hardware and software and utilizes, for example, a payment engine that facilitates the making of payments via the Internet. A user enrolls for the on-line payments service, designates a source account for the on-line payments, and is provided a transaction account as a money deposit account with an account number that the user can use as a source and a destination of funds and with one or more service levels. The user can make, for example, on-line payments, on-line and/or off-line purchases, cash withdrawals at an ATM, credit card account payments, bill payments, and/or international payments with funds in the transaction account and/or a line of credit associated with the transaction account. A quick enrollment aspect of the on-line payments services pre-qualifies the customers of a third party on-line service provider, such as an ISP, for the service. A funds transfer capability aspect provides, for example, an instant availability of funds for the customer.

However, Applicants note that any "self-funding" taught or suggested by Barbara ***does not provide guaranteed, final and irrevocable self-funding of the transaction to the Receiver Financial Institution that prevents any deficiencies in the self-funding,*** as presently claimed.

## **B. Specific Deficiencies of the Applied Art with Respect to the Claims**

### **1. Independent Claim 1**

The applied art does not disclose a computer-implemented method for processing a payment to a foreign financial transaction beneficiary located in a foreign country wherein the

method includes, *inter alia*, "receiving, in a computer processor at a Receiver Financial Institution, a single authorizing foreign financial transaction payment instruction from a Client Bank over a computer network in a format associated with a domestic settlement funds transfer system used for funding domestic credit transfer transactions that provides guaranteed transaction self-funding of the foreign transaction to the Receiver Financial Institution that ensures no deficiencies in the self-funding; analyzing, by the computer processor, the received single authorizing foreign financial transaction payment instruction; and generating, in the computer processor, foreign financial transaction payment instructions for at least one financial institution located in a foreign country and transmitting the foreign financial transaction payment instructions over the computer network, the foreign financial transaction payment instructions including data in a funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution, wherein said guaranteed, self-funding of the foreign transaction comprises both the Receiver Financial Institution and the Client Bank being members of the domestic settlement funds transfer system, wherein said members are required to settle transactions initiated using the system daily, and wherein any deficiencies in foreign funding amounts are prevented by guarantee procedures of a central banking authority that controls the domestic settlement funds transfer system," as recited in independent claim 1, as amended (*emphasis added*).

## 2. Independent Claim 13

The applied art does not disclose a mechanism for processing a payment to a financial transaction beneficiary located in a foreign country, wherein the mechanism includes, *inter alia*, "a computer network interface at a Receiver Financial Institution *configured to receive a single authorizing foreign payment instruction from a Client Bank in a format associated with a domestic settlement funds transfer system used for funding domestic credit transfer transactions and that provides guaranteed transaction self-funding of a foreign transaction to the Receiver Financial Institution that ensures no deficiencies in the self-funding*; and at least one processor including software for analyzing the received single authorizing foreign payment instruction and *generating foreign financial transaction payment instructions for at least one financial institution located in a foreign country, the foreign financial transaction payment instructions including data in a domestic funds transfer messaging service format that is*

*compatible with both the Receiver Financial Institution and the at least one financial institution, wherein said self-funding of the foreign transaction comprises both the Receiver Financial Institution and the Client Bank being members of the domestic settlement funds transfer system, wherein said members are required to settle transactions initiated using the system daily, and wherein any deficiencies in foreign funding amounts are prevented by guarantee procedures of a central banking authority that controls the domestic settlement funds transfer system,"* as recited in independent claim 13, as amended (*emphasis added*).

Accordingly, since the applied art does not teach or suggest all the claimed limitations, reconsideration and allowance of independent claims 1 and 13 are respectfully requested. In addition, dependent claims 2-5, 7-12, and 14-24 variously and ultimately depend from these patentable independent claims, and are submitted as being allowable at least on that basis, without further recourse to the patentable features recited therein.

## **VI. Unpatentability Rejection of Claims 4 and 16 under 35 U.S.C. § 103(a) over Lawrence and Barbara in View of SWIFT.COM**

Withdrawal of the rejection of claims 4 and 16 under 35 U.S.C. §103(a) as being unpatentable over Lawrence and Barbara in view of SWIFT.COM is requested. The deficiencies of Lawrence and Barbara been discussed above, particularly with respect to independent claims 1 and 13, as amended.

The Examiner admits that Lawrence and Barbara are deficient with respect to providing a teaching or suggestion of “foreign financial transaction payment instructions which comply with SWIFT MT 103 specifications (i.e. messaging standards),” and alleges that SWIFT.COM makes up for this admitted deficiency.

### **A. Discussion of SWIFT.COM and its Deficiencies**

This non-patent literature reference is relied upon by the Examiner to provide a teaching of the SWIFT MT103 message. While the use of SWIFT MT103 is certainly acknowledged, SWIFT.COM, however, does not make up for the deficiencies of Lawrence discussed above with respect to the unpatentability rejection of independent claims 1 and 13, from which claims 4 and 16 respectively depend, as further discussed below.

In particular, SWIFT.COM does not teach or suggest receiving financial transaction payment instructions from a Client Bank in a format *associated with a settlement funds transfer system that provides guaranteed self-funding of the transaction* to a Receiver Financial Institution, as variously recited in independent claims 1 and 13, from claims 4 and 16 depend.

Since the combination of Lawrence/Barbara and SWIFT.COM do not teach or suggest all the claimed limitations of independent claims 1 and 13 (either before or after amendment) from which claims 4 and 16 respectively depend, reconsideration and allowance of claims 4 and 16 are respectfully requested.

## **VII. Unpatentability Rejection of Claim 25 under 35 U.S.C. § 103(a) over Lawrence and Barbara in View of Official Notice**

Withdrawal of the rejection of claim 25 under 35 U.S.C. §103(a) as being unpatentable over Lawrence and Barbara in view of Official Notice is requested. Without agreeing with the propriety of the reliance upon "Official Notice", claim 25 has been amended in a manner that is believed to clarify the recitations. The deficiencies of Lawrence and Barbara been discussed above, particularly with respect to independent claims 1 and 13.

### **A. Specific Deficiencies of the Applied Art with Respect to the Claims**

#### **1. Independent Claim 25**

The applied art does not disclose a computer-implemented method for processing a foreign payment to a financial transaction beneficiary located in a foreign country, wherein the method includes, *inter alia*, and in the order indicated: "(a) *receiving, in a computer system at a Receiver Financial Institution, a single authorizing foreign funds transfer instruction from a Client Bank in a format associated with a domestic settlement funds transfer system used for funding domestic credit transfer transactions and that provides guaranteed transaction self-funding of the foreign payment to the Receiver Financial Institution that ensures no deficiencies in the self-funding*; (b) ensuring compliance of the single authorizing foreign funds transfer instruction with one or more government requirements; (c) if the single authorizing foreign funds transfer instruction is compliant with the one or more government requirements, ensuring, via the computer system, that any required data fields in the single authorizing foreign funds transfer instruction meets all data requirements of the domestic settlement funds transfer

system, otherwise, ending processing of the funds transfer instruction; (d) if the single authorizing foreign funds transfer instruction meets said data requirements, crediting an account of the client bank established for foreign payments with an amount associated with the single authorizing foreign funds transfer instruction, otherwise, ending processing of the single authorizing foreign funds transfer instruction and generating an error message in response thereto; (e) after steps (c) and (d) have been carried out and if the single authorizing foreign funds transfer instructions meets said data requirements, *generating, in the computer system, foreign financial transaction payment instructions for at least one financial institution located in a foreign country; and (f) transmitting the foreign financial payment instructions over a computer network, the foreign financial payment instructions including data in a domestic funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution, wherein said domestic settlement funds transfer system requires that both the Receiver Financial Institution and the Client Bank are members of the domestic settlement funds transfer system, wherein said members are required to settle foreign transactions initiated using the system daily, and wherein any deficiencies in foreign funding amounts are prevented by guarantee procedures of a central banking authority that controls the domestic settlement funds transfer system,*" as recited in independent claim 25, as amended (*emphasis* added).

### **VIII. New Claim 26**

Newly-presented dependent claim 26 has been added to avoid the cited art and to further define that which Applicant is entitled to claim. Consideration and allowance of dependent claim 26 are respectfully requested.

### **IX. Conclusion**

All rejections having been addressed, Applicant submits that each of pending claims 1-5 and 7-25 in the present application is in immediate condition for allowance. An early indication of the same would be appreciated.

For any fees that are due, including fees for excess claims, this RCE, and/or extensions of time during the pendency of this application, please charge Deposit Account Number 03-3975 under Order No. 201818-0307164 from which the Undersigned Attorney is authorized to draw.

The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

**Due Date: August 9, 2010**

Respectfully submitted,

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